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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,727	03/04/2002	Shalom Levi	1268-083A	2222

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EXAMINER
TRAN, SUSAN T

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/086,727	LEVI ET AL.	
	Examin r	Art Unit	
	Susan Tran	1615	

-- The MAILING DATE of this communication appears n the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-13,15,16 and 19-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-13,15,16 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt is acknowledged of applicant's Information Disclosure Statement filed 03/04/02, and Amendment A filed 03/04/02.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 15 and 16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,413,506. This is a double patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "according to claim 10 or 11, wherein the limonene" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Neither claim 10 or 11 recites the limitation "limonene".

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-11, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. US 4,909,986.

Kobayashi teaches aqueous deodorant composition comprising water-soluble polymer having molecular weight higher than 15,000, perfumes, citric acid, and other additives (columns 1-2). The water-soluble polymer can be selected from nonionic, anionic, cationic, or amphoteric, including polyacrylic acid or polyacrylamide (columns 5-7, and examples). The aqueous deodorant composition can be applied by spraying onto liquid or solid selected from cattle raising farm, chicken farm, and livestock product, which has malodor and/or gives off malodors (columns 10-12).

The examiner notes the use of the transitional phrase "consisting essentially of" in claim 1. However, since the prior art composition has the same basic and novel characteristic (aqueous deodorant to remove malodors from animal farm), it is an applicant's burden to establish that other additives in the prior art composition are

excluded from the claim by "consisting essentially of" language. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ at 1355. Furthermore, even when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

It is noted that the reference does not teach that the composition facilitating easy handling of said deodorized excrement recites in claim 21, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5-11, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

Kobayashi is relied upon for the reason stated above. In the case that the applicant can overcome the above 102 rejection, it is the position of the examiner that it would have been obvious for one of ordinary skill in the art to modify Kobayashi's aqueous deodorant composition with the expectation of at least similar result. The reason is Kobayashi teaches the use of the same water-soluble polymer, the same carboxylic acid for the same purpose, *e.g.*, to remove malodors from livestock.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., and Shimizu US 4,839,089.

Kobayashi is relied upon for the reasons stated above. The reference is silent as to the specific perfume, such as limonene.

Shimizu teaches deodorant composition comprising perfume selected from alpha-pinene, terpenoid, and limonene (column 6, lines 34-36). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare Kobayashi's deodorant composition using limonene as perfume in view of the teaching of Shimizu, because the references teach the use of perfume to reduce malodors. The expected result would be an aqueous deodorant composition that exhibits a deodorizing effect on liquids and solids, which give off odors.

Claims 1, 5-10, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. US 5,882,638.

Dodd teaches aqueous odor-absorbing composition comprising citric acid and water-soluble polymer having molecular weight higher than 15,000, *e.g.*, polyacrylic acid (columns 6-7). Dodd does not teach the use of the composition on animal excrement, and/or composition facilitating easy handling of said deodorized excrement. However, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hashimoto and Egberg are cited as of interest for the teaching of deodorant composition.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600